

PTO/SB/21 (09-04)
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/821,726
	Filing Date	April 8, 2004
	First Named Inventor	Michael W. GRAHAM
	Art Unit	1632
	Examiner Name	Not Yet Assigned
Total Number of Pages in This Submission	7 + 2 Exs.	Attorney Docket Number 546322000305

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input checked="" type="checkbox"/> Information Disclosure Statement (5 pages) <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): 1. PTO/SB/08a/b (1 page) 2. Exhibit A (379 pages) 3. Exhibit B (20 pages) 4. Return Receipt Postcard
<div>Remarks</div>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	MORRISON & FOERSTER LLP (Customer No. 20872)	
Signature		
Printed name	Michael R. Ward	
Date	February 11, 2005	Reg. No. 38,651

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EL 968417046 US, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: February 11, 2005

Signature:

(Laura Tsang)



2-14-05

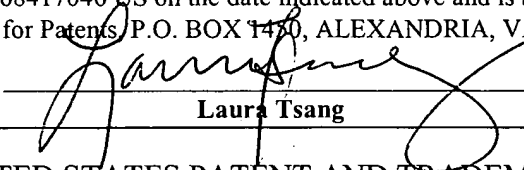
IFa

PATENT
Docket No. 546322000305

CERTIFICATE OF MAILING

Date of Deposit: February 11, 2005

I hereby certify that this paper or fee is being deposited with the United States Postal Service under 37 C.F.R. § 1.10 via Express Mail Label No. EL 968417046 US on the date indicated above and is addressed to: **MAIL STOP: AMENDMENT**, Commissioner for Patents P.O. BOX 1450, ALEXANDRIA, VA 22313-1450.


Laura Tsang

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Michael W. GRAHAM et al.

Serial No.: 10/821,726

Filing Date: April 8, 2004

For: SYNTHETIC GENES AND GENETIC
CONSTRUCTS

Examiner: Not Yet Assigned

Group Art Unit: 1632

**SUPPLEMENTAL INFORMATION DISCLOSURE
STATEMENT UNDER 37 C.F.R. § 1.97 & 1.98**

MAIL STOP: AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.97 and § 1.98, Applicants submit for consideration in the above-identified application the documents listed on the attached Form PTO-1449. Copies of the documents were previously submitted in an Information Disclosure Statement and/or Office Action, directed to the related application Serial Number US 10/346,853, filed January 17, 2003, and, accordingly, copies are not included herewith. This protocol conforms with 37 C.F.R.

§1.98(d) and M.P.E.P. 609(A)(2). The Examiner is requested to make these documents of record in the application.

This application includes in its chain of priority U.S. application 09/100,812, now issued U.S. Patent 6,573,099. The Examiner's attention is directed to the preliminary amendment filed in US 2003/0056235 A1, which relates to U.S. Patent 6,573,099. U.S. Patent 6,573,099 is the subject of ongoing patent litigation: Benitec Australia Ltd. v. Nucleonics, Inc., Ambion, Inc., and GenScript, Inc., Civil Action No. 04-174 (JFF), U.S. District Court for the District of Delaware. As of February 2004, the litigation has been dismissed with respect to defendants Ambion, Inc. and GenScript, Inc. The litigation is ongoing with respect to Benitec Australia Ltd. and Nucleonics, Inc. The Judge in the ongoing litigation recently denied Nucleonics Inc.'s Motion to Dismiss under 271(e).

Applicants respectfully direct the attention of the Examiner to the titles of the 4548 references (without full copies of the references) attached to this Information Disclosure Statement as Exhibit A. This list was provided to the Applicants by defendant Genscript, Inc. prior to Genscript's dismissal from the ongoing patent litigation suit. Applicants have not separately obtained or reviewed any of the 4548 references (even to confirm that the list actually sets out 4548 references), nor have they examined all of the titles, except to the extent that any of the references have already been in the possession of the Applicants (in which case such reference(s) would have been provided to the Examiner if material and not cumulative with references already provided). Applicants have no reason to believe that the references in the list are material to the claimed invention and have no reason to believe that, even if material, any of the references would not be cumulative in light of the over 270 references already submitted during the prosecution of this patent application, other than the submission by the defendant. The Examiner is requested to review the enclosed list of references.

Applicants further direct the attention of the Examiner to the titles of the additional references (without full copies of the references) attached to this Information Disclosure Statement as Exhibit B. This list was provided to the Applicants by defendant Nucleonics, Inc. in the litigation as art that Nucleonics, Inc. may rely on in the ongoing litigation. Applicants have not separately obtained or reviewed any of the references listed on Exhibit B, nor have they examined all of the titles, except to the extent that any of the references have already been in the possession of the Applicants (in which case such reference(s) would have been provided to the Examiner if material and not cumulative with references already provided). Applicants have no reason to believe that the references in the list are material to the claimed invention and have no reason to believe that, even if material, any of the references would not be cumulative in light of the over 270 references already submitted during the prosecution of this patent application, other than the submission by the defendant. The Examiner is requested to review the enclosed list of references.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☒ **Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.**
- ☐ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
 - ☐ A fee is required. A check in the amount of ___ is enclosed.
 - ☐ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly, no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of ___ is enclosed.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission in duplicate.)

Applicants would appreciate the Examiner initialing and returning the Form PTO-1449, indicating that the information has been considered and made of record herein.

The information contained in this Supplemental Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search

has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petitions for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing **546322000305**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: February 11, 2005

Respectfully submitted,

By: Michael R. Ward
Michael R. Ward
Registration No. 38,651

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ALTERNATIVE TO PTO/SB/08a/b (06-03)

Substitute for form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>				Complete if Known	
				Application Number	10/821,726
				Filing Date	April 8, 2004
				First Named Inventor	Michael W. GRAHAM
				Art Unit	1632
				Examiner Name	Not Yet Assigned
Sheet	1	of	1	Attorney Docket Number	546322000305

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			
	AA	US 4,766,072	08-23-1988	Jendrisak et al.	
	AB	US 2003/0056235 A1 with amendments	03-20-2003	Fire et al.	
	AC	US 2004/0064842 A1	04-01-2004	Graham et al.	
	AD	US 2004/0237145 A1	11-25-2004	Graham et al.	
	AE	US 09/646,807		Graham et al.	

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		Country Code ³ -Number ⁴ -Kind Code ⁵ (if known)				
	BA	WO 97/44450	11-27-1997			

*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²

*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	
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